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## RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* VOLKER HENNIGE, CHRISTIAN HYING,  
GERHARD HORPEL, and SVEN AUGUSTIN

Appeal 2009-011171  
Application 10/524,665  
Technology Center 1700

## **Oral Hearing Held: January 21, 2010**

Before BRADLEY R. GARRIS, CHARLES F. WARREN, and  
TERRY J. OWENS. *Administrative Patent Judges.*

## APPEARANCES:

## ON BEHALF OF THE APPELLANT:

HARRIS A. PITLICK, ESQUIRE  
Oblon, Spivak, McClelland, Maier & Neustadt, LLP  
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Alexandria, Virginia 22314

1       The above-entitled matter came on for hearing on Thursday, January  
2 21, 2010, commencing at 9:12a.m., at the U.S. Patent and Trademark Office,  
3 600 Dulany Street, Alexandria, Virginia, before Deborah Rinaldo, Notary  
4 Public.

5 JUDGE GARRIS: I think we're ready to start the next one.

6 MR. PITLICK: Okay. In this case, somewhat related technology and I realize  
7 since this is being recorded, no one will know what I'm talking about, but at  
8 any rate, we can ignore what I just said and I'll start from the beginning.

9 The invention here is a separator electrode unit, again, for use in a battery such  
10 as a lithium battery.

11 So we have a porous electrode and we have a separator which is inorganic. It's  
12 got -- there's an inorganic separator layer which has two fractions of metal  
13 oxide particles. And one fraction has an average particle size that's greater  
14 than the pore size of the electrode and another fraction having a pore size -- a  
15 particle size that's less -- that's less than the average pore size of the porous  
16 electrode. And the metal oxides don't have to be the same for each.

17 So we have one rejection, namely under 35 USC 103(a) over Yamashita, et al.,  
18 in view of Penth, et al.

19 Yamashita, et al., has a porous separator, doesn't say anything specifically  
20 about the porosity of the electrode, but we're not arguing that it's not porous,  
21 but -- we are not really sure whether it is or not. But the main point is, again,  
22 our separator is inorganic, Yamashita requires an organic binder.

23 And while the term preferably does -- or "preferred" appears one time in there,  
24 I think it's clear from the disclosure as a whole in Yamashita that they have to  
25 have the organic binder because there's no other disclosed way of, in effect,  
26 binding the remaining materials in their separator.

1 So the Examiner relies on Penth, et al., for purposes of showing the inorganic  
2 separator of the present claims. But as we pointed out, Penth, et al., discloses  
3 nothing about the particular use as a separator in a battery. As we've pointed  
4 out, Penth is basically drawn to the ability of their material to be catalytically  
5 active.

6 And while various utilities are disclosed in Penth, they are all pretty much  
7 geared to being able to use that as being catalytically active.

8 Now, the Examiner relies on the fact that the words "cathode" and "anode"  
9 appear in Penth. But it's clear it has nothing to do with a cathode or anode that  
10 would be used in a lithium battery.

11 So even if one skilled in the art were to combine Yamashita and Penth, and we  
12 believe they wouldn't do that without our disclosure as a guide, the result  
13 would not be the presently claimed invention on many levels certainly.

14 One level certainly is the fact that you have the two particle size ranges and the  
15 fact that the ranges are related to the pore size of the electrode.

16 So again, I think it's a pretty straightforward case here and certainly will be  
17 happy to answer any questions you might have.

18 JUDGE GARRIS: Any questions?

19 JUDGE WARREN: No.

20 JUDGE OWEN: No.

21 JUDGE GARRIS: No questions. Thank you very much, Mr. Pitlick.

22 MR. PITLICK: You are welcome.

23 Whereupon, the proceedings at 9:16 a.m., were concluded.

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